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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/661,459	09/13/00	MATSUDA M	000004.00066

EXAMINER

QM22/0228

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ART UNIT	PAPER NUMBER
3724	5

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/661,459	Applicant(s) MATSUDA ET AL.	
	Examin r Charles Goodman	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 September 2000* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *10-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *10-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☒ The proposed drawing correction filed on *13 September 2000* is: a)☒ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 .
18) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other:

DETAILED ACTION

1. The Preliminary Amendment filed on September 13, 2000 has been entered.

2. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on September 13, 2000 have been approved.

Priority

3. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

An application in which the benefits of an earlier application are desired must contain a specific reference to the prior application(s) in the first sentence of the specification (37 CFR 1.78).

Claim Objections

4. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 36-57 have been renumbered 10-31.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

i. In claim 27, the phrase "transferring reversely the workpiece in *a first direction...*" (emphasis added) is vague and indefinite in that it is not clear what the phrase encompasses. If the work piece is transferred reversely, would not the direction be opposite to the first direction?

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 10, 11, 13, 15, 16, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Dunn.

Dunn discloses a linear punch press comprising all the elements claimed including, inter alia, a body frame 20, 22, 30; a table 78; a first positioning device 86, 106, 106a for positioning a work piece in a first direction, wherein the first positioning device includes a first clamp (e.g., 106, Fig. 10) to clamp a first margin of the work pieces and a second clamp (e.g., 106a, Fig. 10) to clamp a second margin opposite to the first margin of the work piece, wherein the first clamp can be moved to approach the

second clamp (see e.g. Fig. 10 and c. 3, ll. 53-59 which clearly shows the clamps 106 and 106a with either one adjustably slidably approaching each other); a second positioning device 86, 106, 106a (see Fig. 2) for positioning the work piece in the first direction; a working head 22 positionable in a second direction perpendicular to the first, wherein the positioning devices are arranged in series. See Figs. 1-13, c. 2, l. 31 - c. 5, l. 51.

Regarding claim 21, the method is anticipated by Dunn. See *Id.*

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 12, 22, and 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn in view of Graf et al.

Dunn discloses the invention substantially as claimed except for the work piece being a material uncoiled from a coiled material. However, although Dunn is silent as to the sheet work piece being from coiled material, it is old and well known in the art to utilize the device and method of Dunn for punching sheet material uncoiled from a coiled material as evidenced by Graf et al. Graf et al clearly teaches a punching device and method wherein positioning devices 80, 105 are used to clamp and feed sheet shaped material uncoiled from a coiled material to a punching station 1 (see Fig. 1) for the inherent advantage of machine processing economy, i.e. less down time caused by intermittent feeding of discontinuous work piece sheets, that a longer continuous work piece material affords. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device and method of Dunn with the coiled material as taught by Graf et al for the reasons stated *supra*.

Alternatively, the coiled material has not been given significant patentable weight, since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Moreover, at least with respect to the apparatus claims, the claimed "coiled material" fails to further limit the structure of the invention to the extent necessary for any significant patentable consideration since the work piece itself does not define any *structure*. The claims also lack any specific structural detail that is distinctive for the "coiled material." Furthermore, with respect to the method claim 22, the claim lacks any positive method steps since the "coiled material" does not affect the method in a manipulative sense, but rather the claim sets forth an alternative

work piece. *Ex parte Pfeiffer*, 1962 C.D. 408 (1961). Thus, for all the foregoing reasons, it is not subject to significant patentable weight.

12. Claims 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn in view of Graf et al as applied to claims 12, 22, and 28-31 above, and further in view of Kindgren et al.

The modified method of Dunn discloses the invention substantially as claimed including the inherent and obvious step of simultaneously transferring the work piece by both first and second positioning devices since handling work pieces of various lengths would require simultaneous movement of the positioning devices at some point in time in order to insure that the work piece is properly clamped and fed through the punching station, especially when the positioning devices of Dunn are the main positioning, clamping, and feeding means to do so. See Dunn, c. 4, l. 49 - c. 5, l. 51. However, if it is argued that Dunn lacks such a step, then Kindgren et al teaches the step of transferring a work piece 16 in a first direction by first and second positioning device 27, 28 simultaneously for the purpose of properly clamping and feeding work pieces of various lengths through the punching station 15. See c. 6, l. 31 - c. 7, l. 64. Thus, it would have been obvious to the ordinary artisan at the time the invention was made to provide the modified method of Dunn with the step of simultaneously moving the first and second positioning devices in the first direction as taught by Kindgren et al in order to facilitate proper positioning of the work piece through the punching station.

13. Claims 10, 11, 13-16, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kindgren et al in view of Dunn.

Kindgren et al discloses the invention substantially as claimed except for the first positioning mechanism having a second clamp. However, Dunn teaches positioning devices 86, 106, 106a wherein each device has a plurality of clamps 106, 106a which clamp two side margins of a work piece for the purpose of providing a more secure positioning of the work piece. Moreover, either one of the clamps approachable to each other to adjust for various widths work pieces. See Figs. 1, 2, 4, and 10, c. 4, l. 49 - c. 6, l. 51. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device of Kindgren et al with the plurality of clamps as taught by Dunn in order to facilitate enhanced engagement of work pieces of varying sizes for positioning.

Regarding claim 21, the modified device and method of Kindgren et al would include these method steps.

14. Claims 12, 22-25, and 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kindgren et al in view of Dunn as applied to claims 10, 11, 13-16, and 21 above, and further in view of Graf et al.

The modified device and method of Kindgren et al discloses the invention substantially as claimed except for the work piece being a material uncoiled from a coiled material. However, although Kindgren et al, modified, is silent as to the sheet work piece being from coiled material, it is old and well known in the art to utilize the device and method of Kindgren et al for punching sheet material uncoiled from a coiled material as evidenced by Graf et al. Graf et al clearly teaches a punching device and method wherein positioning devices 80, 105 are used to clamp and feed sheet shaped material uncoiled from a coiled material to a punching station 1 (see Fig. 1) for the

inherent advantage of machine processing economy, i.e. less down time caused by intermittent feeding of discontinuous work piece sheets, that a longer continuous work piece material affords. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the device and method of Kindgren et al with the coiled material as taught by Graf et al for the reasons stated *supra.*

Alternatively, the coiled material has not been given significant patentable weight, since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Moreover, at least with respect to the apparatus claims, the claimed "coiled material" fails to further limit the structure of the invention to the extent necessary for any significant patentable consideration since the work piece itself does not define any *structure.* The claims also lack any specific structural detail that is distinctive for the "coiled material." Furthermore, with respect to the method claim 22, the claim lacks any positive method steps since the "coiled material" does not affect the method in a manipulative sense, but rather the claim sets forth an alternative work piece. *Ex parte Pfeiffer*, 1962 C.D. 408 (1961). Thus, for all the foregoing reasons, it is not subject to significant patentable weight.

15. Claims 17-20, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kindgren et al in view of Dunn as applied to claims 10, 11, 13-16, and 21 above, and further in view of Ikeda et al '441.

The modified device and method of Kindgren et al discloses the invention substantially as claimed except for the details of the working head, i.e. the upper tool holder, the lower tool holder, the ram, and the ram positioning mechanism. However, Ikeda et al '441 teaches a working head comprising an upper tool holder 19, 21 holding a plurality of upper tools, a lower tool holder 33 holding a plurality of lower tools, a ram 73 for actuating the upper tools and the lower tools to work the work piece, and a ram positioning mechanism 87, 97 shifting the ram in first and second directions for the purpose of selectively activating a desired tool to perform the work. See Figs. 1-4, c. 4, l. 60 - c. 6, l. 36. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the modified device and method of Kindgren et al with the upper tool holder, lower tool holder, ram, and ram positioning mechanism as taught by Ikeda et al '441 in order to facilitate diverse working of the work piece vis-à-vis selective actuation of desired upper and lower tools.

Conclusion

16. Saotome et al, Berge, Hosaka, Kakimoto, Ikeda et al, Haar '817, Flick et al, Smith, Miyama, Del Fabro et al, Hunter et al, Hosoi et al, Scott et al, Herb et al, Schott Jr., Graf et al, Reimbold (WO 93/06978), Nakao (JP 403265298), Ferguson (WO 86/00547), and Gardner (GB 2155838) are cited as pertinent art for completeness. These have been cited by the Examiner in the parent application, Application Serial No. 08/836,029; thus, no copies thereof will be sent since Applicant is already in possession of these references. The same applies to the applied references not accounted for in the Applicant's IDS.

In addition, the following new references are also cited as pertinent art: Kouno, Seto et al '731, Zanette, Seto et al '733, Haar '640, Shoda, and Bihler et al. Copies of these are included.

17. This is a continuation of applicant's earlier Application No. 08/836,029. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Goodman whose telephone number is (703) 308-0501. The examiner can normally be reached on Monday-Thursday between 7:30 AM to 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada, can be reached on (703) 308-2187. The fax phone number for this Group is (703) 305-3579.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [**rinaldi.rada@uspto.gov**].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.

Charles Goodman
Patent Examiner
AU 3724

cg
February 26, 2001